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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,460	04/29/2002	Juergen Lorenz	125931-00104	4081

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EXAMINER

HAIDER, SAIRA BANO

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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11/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/009,460

Applicant(s)

LORENZ ET AL.

Examiner

Saira Haider

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/4/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The rejections have been maintained and the response to arguments is provided below.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 14-18 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Czerwinski et al. as evidenced by Hawley's (Polyvinyl Acetate article).

4. The reference teaches thixotropic compositions comprising a liquid material and leather fibers (col. 2 lines 20-22), where polyvinyl acetate and other thermoplastics are taught as liquid coating composition binders (col. 5, lines 21-35). The binders are used in amounts of 1-95% by weight, while the leather fibers are used in amounts up to about 20% by weight (col. 5, lines 36-50). The reference also teaches the claimed fibers lengths (table, col. 12).

5. It is noted that Czerwinski discloses that additional thermoplastics (unsaturated resins) may be solids dissolved in organic liquids, wherein the thixotropic agent (leather fibers) may be directly dispersed in the liquids. Czerwinski discloses polyester resins dispersed in an organic solvent (col. 5, line 65 to col. 6, line 3; col. 6, lines 43-51). It is noted that Czerwinski prefers that the polyester resin is dispersed in a solvent which is copolymerizable with the resin, however, as per MPEP § 2123, the references are valid for all that they contain, including nonpreferred and alternate embodiments.

6. Thus, it is clear, as applicants have argued, that the solvent (or liquid carrier) is present in the composition of Czerwinski. However, post application of the composition of Czerwinski the solvent is removed (via evaporation), thus resulting in a hardened composite material, as claimed. Support is provided by the fact that Czerwinski recognizes the usage of organic solvents, which do not copolymerize with the resin, thus are not incorporated into the final solid composition. Further, the

motivation to utilize a thixotropic composition is for ease of application, and Czerwinski recognizes this via disclosure of a variety of compositions which are thixotropic upon application and hardened post application, including coatings, adhesives, sealants, and the like (col. 3, lines 44-55). Wherein coatings, adhesives and sealants are recognized in the art as hardened in the final state, and capable of withstanding applied shear forces.

7. Thus, the examiner has presented reasoning tending to show inherency, wherein the composition of the reference appears to be substantially identical to that claimed. The burden shifts to the applicant to show an unobvious different. "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the 'characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on '*prima facie* obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Czerwinski, as applied above, in view of Moran (US 4882373).

10. The disclosure of Czerwinski is provided above. Czerwinski provides broad disclosure of suitable thermoplastic compositions including cellulose acetate and polyvinyl chloride (col. 5, lines 21-29). However, Czerwinski fails to expressly disclose that the composition includes a thermoplastic binder comprised of a copolymer of butadiene and styrene. Hence attention is drawn

towards the Moran reference. Moran discloses an asphaltic composition comprising a thermoplastic elastomer (abstract). Specifically, Moran discloses that the asphaltic compositions can be used in additional applications, such as roofing sheets, adhesives and coatings (col. 1, lines 55-62). Czerwinski is considered analogous art to Moran because Czerwinski's composition can be utilized as asphalts (col. 3, lines 44-51). Hence both references drawn to the same field of endeavor.

11. Moran discloses that a way to decrease asphalt's tendency to soften and creep at high temperatures (as well as to improve its low temperature flexibility and solid-like properties) is to add thermoplastic elastomers such as styrene-butadiene-styrene ("SBS") block copolymers. The addition of such polymers serve to modify asphalt for additional applications, such as roofing sheets, adhesives and coatings (col. 1, lines 55-62). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include a styrene-butadiene copolymer in the invention of Czerwinski in order to decrease the resulting asphalt based product's tendency to soften and creep at high temperatures, as well as to improve its low temperature flexibility and solid-like properties. Hence Czerwinski would look towards the teachings of Moran to improve the compositions. Wherein the total amount of thermoplastic binder in the composition of Czerwinski would include the amount of styrene-butadiene copolymer added.

12. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Czerwinski et al. in view of K  chler et al.

13. Czerwinski applies as above, teaching thermoplastic compositions useful as coatings and films but failing to teach the claimed manufacture process including the treatment, dewatering, and drying steps. K  chler teaches aqueous plastic dispersions of vinyl polymers and filler, where the filler comprises fibrous material (abstract). Preferred fibers include leather fibers (col. 3 lines 20-36).

The reference teaches a process of adding fibers to a plastic dispersion, treating the dispersion with aluminum sulfate in an additive amount of 5-20% by weight, removing the water, and drying the mixture to form a sheet (col. 3 line 52-col. 4 line 13). This process is used to form sheets of vibration-damping properties. Thus, it is the examiner's position that it would have been prima facie obvious to employ the methods of Küchler's invention to form materials with improved vibration damping properties.

14. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czerwinski et al. in view of Toyota.

15. Czerwinski applies as above for the making of leather products, failing to mention the use of hot-melt films to form leather laminates. Toyota teaches a method of bonding leather to a backing material via a hot-melt adhesive to form seating articles having improved mechanical strength (abstract). The molten adhesive would inherently form a film between the two outer layers. It is the examiner's position that it would have been prima facie obvious to use Toyota's article-forming method to form leather articles having improved appearance while having improved mechanical strength.

Response to Arguments

16. Applicant has essentially argued that the examiner has relied on portions of the Czerwinski reference (col. 5, line 62 to col. 6, line 1-3; col. 6, lines 43-51), which require the use of polymerizable liquids. In response, as noted in the rejection above, ¶ 5, the examiner has recognized this disclosure of Czerwinski (col. 5, line 62 to col. 6, line 1-3; col. 6, lines 43-51), but has not relied upon it for the rejection of the claims. Rather, the examiner has cited these portions of the

Czerwinski reference in order to clarify to applicant that this disclosure is considered an alternate embodiment and the reference is valid for all it contains.

17. Applicant has essentially agreed that the above cited portions of Czerwinski disclose thermosetting polymers as opposed to the claimed thermoplastic polymers. As noted above, this disclosure is considered an alternate embodiment, wherein the examiner is not relying on this disclosure for the rejection of the claims. Attention is directed to MPEP § 2123.

18. In regards to the combination of the Czerwinski with the Kuchler or Toyota references, applicant has essentially provided the same arguments set forth in the Remarks of 3/13/2007. Thus, the examiner has essentially repeated the response provided in the Office Action mailed on 6/4/2007.

19. Applicant has argued that the final composition of Czerwinski is gel-like and thus not combinable with the Kuchler or Toyota references. As noted above, post application of the composition of Czerwinski, the solvent is removed (via evaporation), thus resulting in a hardened composite material, as claimed. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the final composite material of Czerwinski via the process disclosed by Kuchler or Toyota references, as discussed above. Further, Czerwinski recognizes that in the cured state, the sealant is transferred into a true elastomeric material (col. 4, lines 10-15). Thus, it is clear that the composition no longer contains the liquid and is in a hardened state. Applicants have not provided evidence or arguments to rebut the examiner's position that the coating, adhesives, and sealants disclosed by Czerwinski are not hardened in the final state.

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saira Haider whose telephone number is (571) 272-3553. The examiner can normally be reached on Monday-Friday from 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Saira Haider
Examiner
Art Unit 1796



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